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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,688	02/10/2004	Howard L. Stein	STEIN-1 CIP	9160

7590 03/05/2007  
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EXAMINER
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BROWN, MICHAEL A

ART UNIT	PAPER NUMBER
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3772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/775,688

Applicant(s)

STEIN, HOWARD L.

Examiner

Michael Brown

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43 and 55 is/are allowed.
- 6) ☐ Claim(s) 1-18, 20-42, 44-54 and 56-60 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-19-05</u> <u>3-19-04</u> | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claims 1-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-54, it isn't clear if the ball includes an aperture and a flat face. It appears that the Applicant intended to have independent claims 1, 26 and 43 recite that the ball could or could not include the aperture and the flat face. However, if claim 1 is interpreted as not having the aperture and the flat face, then claim 2 fails to further limit claim 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 26-32, 46 and 56-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slade (<http://www.lonet.net~tslade/chinball.thm>) in view of Leason '776, along with Moriyama.

Slade teaches the pressing and rolling of an iron freestanding Chinese Health Ball with a diameter of 1.75 inches against the underside surface of the foot and a rigid surface. Slade doesn't disclose the application of a therapeutic hot or cold treatment and weight dimensions. Leason teaches the heating of a steel massage ball 36 by

Art Unit: 3772

heater 120 (col. 4, lines 54-55). Since the claimed massage ball is made of steel, it appears that the massage ball 36 falls within the realm of 6 to 24 ounces because it is within the claimed range of the diameter of the ball. Steel was selected by Leason as the material of composition for its heat absorbing and retaining ability (col. 4, lines 62-65) and wouldn't deform during the massage. It would have been obvious to one provide the massage ball disclosed by Slade with a steel composition and a heating element as taught by Leason in order to provide an effective heated massage to the underside of a user's foot. It would have also been obvious to one having ordinary skill in the art at the time that the invention was made to provide the massage ball disclosed by Slade and taught by Leason with a means to provide therapeutic cold massaging as taught by Moriyama to provide cold thermal stimulation to the underside of the user's foot.

Regarding claim 3, Leason teaches a heater 120 that can be adjusted to provide a range of temperatures which would include 115 degrees Fahrenheit or a temperature between 65 to 75 degrees Fahrenheit. The therapeutic cold device as taught by Moriyama would provide a cold temperature of 55 degrees Fahrenheit or between 65 to 75 degrees Fahrenheit. Regarding claim 4, Leason teaches a warm temperature of at least 95 degrees and Moriyama teaches a cold temperature no greater than 70 degrees Fahrenheit. Regarding claim 5, Slade provides a teaching that the Chinese Health Ball is a smooth metal. Regarding claim 6, Slade provides a teaching that the Chinese Health Balls are 1.75 inches in diameter. Since the ball disclosed by Slade and taught Leason is composed of steel, it appears that the ball must weigh between 12 and 14

ounces because it made of the same material disclosed in the claims of the present invention. Regarding claims 7-8, Leason teaches a massage ball made of stainless steel. It is common knowledge that stainless steel as taught by Leason could be one of the steels recited in claims 7-8.

Claims 9-16, 20-21, 44-45 and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Mencher-Aliazzo.

Mencher-Aliazzo teaches in figure 1 a massaging ball 10 having between 1 to 50 apertures 11, one aperture 11, that runs through the diameter of the ball and the ball contains between two to six apertures 11. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the ball disclosed by Slade and taught by Leason could be fabricated with apertures as taught by Mencher-Aliazzo in order to allow heated water to pass completely through the ball. The diameter of the aperture being between 1/16 and 3/4 or 1/4 and 1/2 inches are a design choices. The aperture intersecting each other is a design choice. The ball having three apertures running through the diameter of the ball, wherein the apertures run through X-, Y- and Z axes is design choice. The diameter of the aperture being 3/8 inches is a design choice. The metal ball disclosed by Slade can be anodized, polished and magnetized.

Claims 17-18 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Nesbitt.

Art Unit: 3772

Nesbitt teaches in figure 1 a ball 10 made of aluminum. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the ball disclosed by Slade and taught by Leason could be fabricated of aluminum as taught by Nesbitt because aluminum is a material that can be heated or cooled to provide a massaging therapeutic effect. The types of aluminum used in claims 17-18 and 60 are design choices.

Claims 22-25 and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Burnham.

Burnham teaches in figure 3 a massage ball comprising a flat face 54 that is circular and has an aperture 56 therein. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the flat face as taught by Burnham could be incorporated into the ball disclosed by Slade and taught by Leason in order to use the flat sides to massage the foot. The diameter of the flat face being between 1/16 to 3/8 inches, the diameter of the flat face being about 1/8 inches and the flat face being at least 1/4 inches in length are design choices.

Claims 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Mencher-Altazzo. Mencher-Altazzo teaches in figure 1 a massaging ball 10 having between 1 to 50 apertures 11, one aperture 11, that runs through the diameter of the ball and the ball contains between two to six apertures 11. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the ball disclosed by

Art Unit: 3772

Slade and taught by Leason could be fabricated with apertures as taught by Mencher-Aliazzo in order to allow heated water to pass completely through the ball. The diameter of the aperture being between  $1/16$  and  $3/4$  or  $1/4$  and  $1/2$  inches are a design choices. The aperture intersecting each other is a design choice. The ball having three apertures running through the diameter of the ball, wherein the apertures run through X-, Y- and Z axes is design choice. The diameter of the aperture being  $3/8$  inches is a design choice. The metal ball disclosed by Slade can be anodized, polished and magnetized.

Claims 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Nesbitt.

Nesbitt teaches in figure 1 a ball 10 made of aluminum. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the ball disclosed by Slade and taught by Leason could be fabricated of aluminum as taught by Nesbitt because aluminum is a material that can be heated or cooled to provide a massaging therapeutic effect. The types of aluminum used in claims 41-42 are design choices.

Claims 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Kobayashi.

Kobayashi teaches a mat comprising a fabric that provides a non-skid surface and magnetic properties (magnets 20). It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the mat as taught by

Art Unit: 3772

Kobayashi could be used to prevent the ball from slipping from under the user's foot during the massaging process.

Claims 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims above, and further in view of Holland.

Holland teaches a pouch with an enclosed magnet. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the pouch as taught by Holland could be used to store the ball disclosed by Slade and taught by Leason.

#### ***Allowable Subject Matter***

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 43 and 55 are allowed.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. No additional prior art other than the references used in this rejection were cited in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brown whose telephone number is 571-272-4972. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Thursday.




Art Unit: 3772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M. Brown  
January 29, 2007

A handwritten signature in black ink, appearing to read "Michael A. Brown", with a long horizontal flourish extending to the right.

MICHAEL A. BROWN  
PRIMARY EXAMINER